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09/919,179	07/30/2001	Klaus Draenert	D06.12-0007	2627

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Nickolas E. Westman  
Westman, Champlin & Kelly, P.A.  
Suite 1600 - International Centre  
900 Second Avenue South  
Minneapolis, MN 55402-3319

EXAMINER

ROBERT, EDUARDO C

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 12/23/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/919,179

Applicant(s)

DRAENERT, KLAUS

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/3/03 & 10/13/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 13, 2003 have been approved.

The drawings are objected to because "Fig. 3-1" is not shown in the Figures filed on July 3, 2003. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office Action, and may not be deferred.

### *Specification*

The disclosure is objected to because of the following informalities:

Reference "100.3" has been used for both "distal segment" and "stem segment" (see paragraph [0007]).

Reference number "301" has been used for both "head prosthesis" and "cone" (see paragraph [0009]).

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Reference number “300” has been used for both “cone” and “prosthesis” (see paragraph [0009]).

The term “shoulder” is used for identify both elements “100.1” and “200” (see paragraph [0009]).

The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. Specifically, the term “a collum centrum axis” does not appear in the specification.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75 (d)(1) and M.P.E.P § 608.01 (1). Correction of the following is required: that at least one tension carrying member is anchored in the femur shaft, as per claim 32, should be properly included in the specification.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 29, line 5, “the disphysial axis” lacks a prior antecedent.

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In claim 32, lines 1 and 2, “a femur shaft” is recited in addition to the femoral component which includes the base stem segment and shoulder segment, which would not appear to be the case in the disclosed invention. It is noted that as disclosed the femoral component, i.e. “100” is the same thing as the femur shaft (see applicant’s specification, page 2, paragraph 0006, lines 7-13). In line 6, “the support surface of the femur shaft” lacks a prior antecedent. In line 7, “the shoulder section” lacks a prior antecedent. In line 8, “the exterior of a femur” lacks a prior antecedent. Also, in lines 9-10, “the shoulder segment and femur shaft and head prosthesis are supported on a femur” is indefinite because it is unclear how two shoulder segments are supported on a femur, i.e. a shoulder segment and a shoulder segment which is part of the femur shaft. It is noted that as disclosed the femur shaft is 100 which comprise parts 100.1, 100.2, and 100.3 (see Figure 1).

In claim 33, line 2, “the support surface on the femur shaft” lacks a prior antecedent. In line 3, “neck prosthesis” lacks a prior antecedent.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29 and 31, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kranz et al. (U.S. Patent 6,102,956).

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Kranz et al. disclose a femoral component comprising a stem segment, e.g. 2, having a tip portion and a cylinder portion, e.g. 11, extending from the tip portion along an axis. The femoral component further comprises a shoulder segment 1 having a bore or hole 10 which receives the cylinder portion 11. The shoulder segment has a surface centered around an axis.

Claims 29-33, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kranz et al. (U.S. Patent 4,878,917).

Kranz et al. disclose a femoral component comprising a stem segment 40 having a tip portion and a cylinder portion 15 extending from the tip portion along an axis (see Figure 2). The femoral component further comprises a shoulder segment 1 having a bore or hole which receives the cylinder portion 15 (see Figure 2). The femoral component also includes an intermediate stem segment, e.g. 5 and 9, fitted on the cylinder portion 15 between the stem segment 40 and the shoulder segment 1 (see Figure 2). The shoulder segment has a surface centered around an axis. The femoral component will include a head prosthesis, i.e. a ball fitted on the cone 2. It is inherent that the ball has a support surface. The shoulder also has a medial surface centered around an axis. The cylinder portion 15 can be considered a tension member and is attached to the femoral component. The medial surface has a concave groove (see Figure 2).

### ***Response to Arguments***

Applicant's arguments with respect to new claims 29-33 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Kranz (U.S. Patent 6,102,956) does not show shaft elements supported on a cylinder member such as cylinder 103, it is noted that the law of

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anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In the instant case Kranz shows cylinder portion as require in the claim (see rejection above).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

The cancellation of claims 16-28 and addition of new claims 29-33 require the new ground of rejection.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

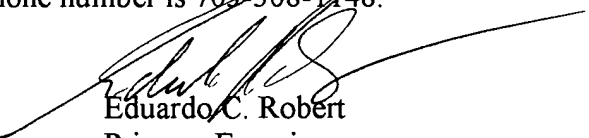
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333.

The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.